

REMARKS

Summary

Claims 45-63, 69-72, and 74-78 were pending. In the present response, no claims are cancelled, amended, or added. No new matter has been introduced.

Accordingly, claims 45-63, 69-72, and 74-78 remain pending.

Rejections Under 35 USC 102(e)

Claims 45-63, 69-72, and 74-78 were rejected under 35 USC 102(e) over Shiloh (US 2001/0037316) or Shiloh (US 7,412,422) (hereinafter the references will be referred to collectively as “Shiloh” unless otherwise indicated).

1.131 Declaration

Applicant submits a declaration herewith to remove Shiloh as a reference as of its nonprovisional patent application filing date of March 22, 2001.

Shiloh has a filing date of March 22, 2001, based on a US provisional patent application filing date of March 23, 2000. The inventor of the present application (G. Eric Engstrom) invented the claimed invention prior to March 22, 2001. And, the disclosure of the provisional patent application (US Provisional Patent Application No. 60/191,625) does not teach or suggest all of the features of the pending claims.

Please find attached a Declaration submitted by G. Eric Engstrom, the inventor of the instant application, in accordance with 37 C.F.R. 1.131.

The attached Declaration from G. Eric Engstrom establishes that the relevant inventive subject matter was conceived at least as early as January 31, 2001, which is the date of an earlier draft of the present application (Exhibit 1). The disclosure provided by Exhibit 1 shows earlier invention at least with respect to the disclosure of Shiloh as of March 22, 2001, and with respect to the features for which Shiloh was cited.

The Final Office Action indicated that the previously submitted Declaration was ineffective because (1) it did not clearly establish conception prior to the effective date, and (2) there were no statements pertaining to patent counsel's diligence.

The inventor Declaration provided herewith includes a copy of an earlier draft of the patent application (Exhibit 1) prepared on or about January 31, 2001, clearly establishing conception of the claimed invention prior to the effective date of the reference (March 22, 2001).

In addition, a Declaration of patent counsel, Al AuYeung, is provided to detail patent counsel's diligence. As established by both Declarations, the inventor and patent counsel were diligent from a date prior to the effective date of Shiloh to the constructive reduction to practice of the present application.

Accordingly, Applicant respectfully submits that the disclosure of Shiloh as of March 22, 2001, may not be used as a reference against the instant application.

As noted further below, the '625 provisional patent application does not teach or suggest the features of the pending claims, or the features for which its successor application was cited. As such, the Examiner cannot establish a *prima facie* case of obviousness based on the '625 provisional patent application. Thus, Applicant requests the Examiner to withdraw the rejection.

US Provisional Patent Application No. 60/191,625 to Shiloh

The '625 provisional patent application provides a virtual personality provider configured for the creation and use of virtual entities for performing various actions on-line anonymously by a user. However, the '625 provisional patent application does not teach or suggest "in response to the request [for registration information], the device causing a second service provider to dynamically generate and provide a personality profile having one or more personality characteristics to portray a desired persona," as recited in claim 45.

The '625 provisional patent application only discloses users creating personalities or the system generating personalities as predefined entities, not to "dynamically generate" them "in response to [a] request. . . ." At page 5 of the '625 provisional patent application, the disclosure provides that "[v]irtuality will create a series of exclusive (*e.g., copyrighted and/or trademarked*) virtual personalities, having predefined attributes. These personalities will be sold to interested Virtuality users, *e.g., using an auction-type system.*" This disclosure provides for the generation of stock personalities, not dynamic

generation in response to a “request for registration information.” There is no other related disclosure in the ‘625 provisional patent application. Claim 45 is thus distinguishable over the ‘625 provisional patent application for at least this reason.

In addition, for at least the above-identified reasons, the Examiner cannot establish a *prima facie* case of obviousness as the ‘625 provisional patent application does not disclose or suggest the features of the pending claims.

Claims 52, 58, 69, 74, and 75 contain language similar to that of claim 45 and thus are patentable over the ‘625 provisional patent application for at least the same reasons.

Claims 46-51, 53-57, 59-63, 70-72, and 76-78 are dependent, directly or indirectly, on the independent claims, and thus are patentable over the ‘625 provisional patent application for at least the same reasons discussed above.

Furthermore, in claim 52, and similarly in claims 69, 74, and 75, the profile that is generated and the personality characteristics that are provided are “based at least in part on content of a service provided by the first service provider. . . .” Such a feature is supported in the Specification, for example from page 11, line 13 to page 12, line 8, in which the provided personality characteristics are determined from information about the service(s) offered by the service provider. No such teaching is provided in the ‘625 provisional patent application. The Office Action relied on Column 4, lines 30-42, of Shiloh for providing this teaching. While Applicant does not agree with this assertion, the ‘625 provisional patent application, in particular, does not provide a corresponding disclosure.

Thus, the claims are patentable over the ‘625 provisional patent application.

Conclusion

In view of the foregoing, Applicant respectfully submits that the claims are in condition for allowance and early issuance of a Notice of Allowance is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 796-2844. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

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